

Applicant: Allen R. DeCotiis, Martha M. Rea
Serial No.: 09/816,794
Filed: March 22, 2001
Examiner: Calvin L. Hewitt II
Attorney File No.: 44000-04225

Group Art Unit: 3621

Amendment and Response to Office Action

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REMARKS

This is a complete and timely response to the outstanding non-final Office Action mailed October 20, 2004. Claims 1 – 18 remain pending. As indicated above, Applicants amended independent claims 1, 7, and 13. Applicants respectfully request that the application and presently-pending claims be reconsidered and allowed.

I. Petition for One-Month Extension of Time

Pursuant to 37 C.F.R. §1.136(a), Applicants submit the attached Petition for Extension of Time, requesting an extension of time of one month -- extending the time for responding to the non-final Office Action mailed October 20, 2004 to February 22, 2005. Pursuant to 37 C.F.R. 1.7, the period for responding to the outstanding Office Action within the one-month extended time period (which expires on February 20, 2005) is extended to February 22, 2005 because of the intervening Saturday, Sunday, and Federal Holiday (President's Day).

II. Claims 1 – 18 are Directed to Statutory Subject Matter

The Office Action rejects claims 1 – 18 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Specifically, the Office Action alleges that independent claim 1 “is merely an abstract idea (e.g., a mathematical formula) as it is not tied to the computer arts.” With regard to independent claims 7 and 13, the Office Action asserts that:

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Claim 7 recites “computer code”, while claim 13 recites “logic”. However, the computer code is not stored on a computer readable medium and the “logic” is not embedded in a computer, for example, that is used to implement the claimed system.

Without acquiescing to the merits of this rejection, Applicants note that independent claims 1, 7, and 13 have been amended as indicated above to further clarify that the method recited in independent claim 1 is “at least partially implemented via a computer”, the computer program recited in independent claim 7 is “embodied in a computer-readable medium”, and the system recited in independent claim 13 comprises “at least one processing unit for implementing” the recited logic. Accordingly, Applicants respectfully assert that independent claims 1, 7, and 13 are directed to statutory subject matter and, therefore, the rejection under §101 should be withdrawn and the claims be allowed.

III. Claims 1 - 18 are Patentable Over U.S. Patent No. 6,505,168 in View of U.S. Patent No. 6,233,564

The Office Action rejects claims 1 – 18 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,505,168 to Rothman *et al.* (“the ‘168 patent”) in view of U.S. Patent No. 6,233,564 to Schulze (“the ‘564 patent”). Specifically, the Office Action alleges that the ‘168 patent teaches all of the claim limitations except “using surveys to collect information on an intent to purchase a particular product.” In support of the §103 rejection, however, the Office Action argues that (1) the ‘564 patent teaches “asking customers about

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‘anticipated major purchases’ ” and (2) it would have been obvious to one of ordinary skill in the art to combine the teachings of the ‘168 patent and the ‘564 patent “in order to allow goods and services providers to more effectively and directly target consumers.” Applicants respectfully submit that the rejection under §103 should be withdrawn because the Office Action fails to establish a prima facie case of obviousness. Specifically, the Office Action fails to establish the proper suggestion or motivation to combine the ‘168 patent and the ‘564 patent in the manner suggested.

In order to establish a prima facie case of obviousness by combining references, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill, to modify the primary reference (the ‘168 patent) in the manner allegedly taught by the secondary reference (the ‘564 patent). *See e.g.*, MPEP §§2142, 2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). It is well-established law that, in order to properly combine select elements from differing sources, there must be some teaching or suggestion *within the prior art* to make

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the combination specifically claimed by the applicant's invention. *W.L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art ... ***Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure...*** In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention.

(emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

The Federal Circuit has also noted that “[h]umans must work with old elements, most if not all of which will normally be found somewhere in an examination of the prior art.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549, 220 USPQ 193 (Fed. Cir. 1983). Furthermore, the fact that features, even distinguishing features, are “disclosed” in the prior art is alone insufficient to establish a prima facie case of obviousness. As indicated above, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention, as a whole, in light of all teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Id.*

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In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest *both* the combination of elements *and* the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 F.2d. 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must suggest the desirability of combining the particular elements.

Applicants respectfully submit that the purported motivation or suggestion provided in the Office Action is not sufficient reasoning to establish a prima facie case of obviousness. In fact, the scarce line of reasoning is cited below in its entirety:

[I]t would have been obvious to one of ordinary skill in the art to combine the teachings of [the '168 patent] and [the '564 patent] in order to allow goods and services providers to more effectively and directly target consumers ('564, column 2, lines 23 – 30).

Applicants respectfully submit that this rationale is alone insufficient.

The '168 patent discloses a system and method for gathering and standardizing customer purchase information for target marketing. The customer scoring system disclosed in the '168 patent involves scoring individual customers based on the manner in which their customer information is placed into an organizational structure. The scoring system is performed customer by customer based on the mapping of the individual customer information to the standard organizational structure. The organizational structure is "a hierarchical structure of categories and sub-categories" that defines a standardized method for scoring each individual customer.

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Figure 1, col. 3, ll. 21 – 26. Each individual customer score is determined by (1) receiving customer purchaser information associated with the individual customer from a plurality of different sources, (2) placing the customer purchase information for the individual customer into the organizational structure, and (3) generating a score (for the individual customer) based on the placement of the customer information in the organizational structure.

The system of the '168 patent is specifically designed to provide a standardized scoring system for consumers. Customer purchase information for each individual is linked to a standard set of categories and sub-categories that define an organizational structure. The score for each customer is determined based on the placement of the customer purchase information into the organizational structure. Applicants respectfully submit that the '168 patent specifically teaches away from using survey information for each customer for which a score is being calculated.

The scoring system of the '168 patent is designed to standardize the scoring of customers based on placement of their purchase information within the organizational structure, so that customer surveys do not have to be performed for each customer. In other words, the scoring system of the '168 patent was specifically designed to avoid the problems associated with surveying

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customers. For example, the '168 patent clearly states in the Background of the Invention:

Customer research, including survey information, may assist a marketer in providing services and goods that are wanted. Surveys, however, do not address the particular needs or wants of an individual customer. Surveys, at best, may identify trends among a group of people, not the wants or needs of an individual customer.

Col. 1, ll. 24 – 29.

The '168 patent further teaches away from the use of survey information as follows:

Customer research may also be used to retain existing customers. A company may obtain feed back from existing customers, thereby enabling the company to ascertain what product and services customers want, and how existing products and services can be changed. Such customer research, however, may be difficult to obtain, as it depends upon customers to respond to surveys and/or questions. Meaningful customer feedback may be impractical for companies with large numbers of customers, as the only way to obtain feedback may be by use of telephone calls or direct mailings. Customer feedback may not indicate information on how to attract new customers. These and other drawbacks exist.

Col. 2, ll. 30 – 43.

In sum, the clear purpose of the scoring system of the '168 patent is to standardize customer purchase information without gathering survey information from each customer being scored. Therefore, the '168 patent specifically teaches away from combining the standardized

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scoring system with survey information from each each customer, as suggested by the Office Action.

Furthermore, Applicants also note that a combination of the standardized scoring system of the '168 patent with the customer survey methods of the '564 patent would render it unsatisfactory for its intended purpose. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP §2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Again, the clear purpose of the scoring system of the '168 patent is to avoid performing surveys for each customer. Any modification of the '168 patent that proposes the use of survey information for each customer being scored, would render the '168 patent unsatisfactory for its intended purpose. Accordingly, as a matter of law, there is no suggestion or motivation to make the modification proposed in the Office Action. For at least this additional reason, Applicants respectfully request that the rejection under §103 be withdrawn and the claims be allowed.

VI. References Made of Record But Not Applied

The references made of record and considered by the Office to be "pertinent to applicant's disclosure" have been reviewed. Applicants note that none of these references, taken together or individually, disclose, teach, or suggest all of the elements of claims 1 – 18.

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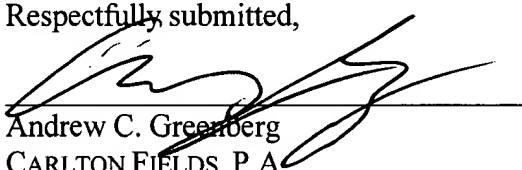
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CONCLUSION

For at least the reasons set forth above, Applicants respectfully submit that all rejections have been traversed, and that pending claims 1 – 18 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are courteously requested.

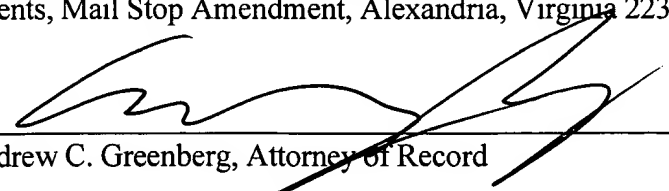
Respectfully submitted,



Andrew C. Greenberg
CARLTON FIELDS, P.A.
P.O. Box 3239
Tampa, FL 33601-3239
(813) 223-7000
Attorney for Applicants
Reg. No. 38476

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Andrew C. Greenberg, Attorney of Record

2/22/05
Date